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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,855

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Kenji Otda

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

06/22/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/554,855	Applicant(s) OTODA ET AL.	
	Examiner CLARK F. DEXTER	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-32,35-48,53,54,56-79 and 84-96 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8-28,31,36-48,53,54,56-79 and 84-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,29,30,32 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2010 has been entered.

Claim Rejections - 35 USC § 112, 2nd paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4, 29, 30, 32 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 7-8, the recitation "has a cross-section along a line of a rotational shaft of the pressing means" is vague and indefinite as to what structure is being set forth; in lines 8-9, the recitation "that contacts the second surface of the brittle substrate" renders the claim vague and indefinite since the invention is positively claimed in terms of the brittle substrate which is not part of the claimed invention.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 29 and 30, as understood, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Le Gras, pn 3,259,286.

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Le Gras discloses a cutting system as follows:

a breaking apparatus (e.g., 12) for breaking a brittle substrate along a scribing line,

wherein the breaking apparatus includes a pressing means (e.g., 20) for pressing a second surface of the brittle substrate, and a first holding means (e.g., 14) for holding a first surface of the brittle substrate, wherein the pressing means moves along the scribing line while the pressing means presses the second surface of the brittle substrate opposing the first surface of the brittle substrate while the first surface of the brittle substrate is being held by the first holding means, and wherein the pressing means has a cross-section along a line of a rotational shaft of the pressing means and an outer periphery that contacts the second surface of the brittle substrate, and wherein the cross-section of the outer periphery is formed in the shape of an arc (e.g., when viewing along a line of the rotational shaft of 20, 20 is clearly formed in the shape of an arc),

wherein a groove section (e.g., 25) is formed in the pressing means such that the pressing means does not contact with a line on the second surface of the brittle substrate, the line opposing the scribing line;

[claim 2] wherein the pressing means moves along the scribing line while the first holding means and the pressing means oppose each other with the brittle substrate therebetween (e.g., as described in col. 4, lines 50-52);

[claim 3] wherein the pressing means rolls along the scribing line;

[claim 4 (from 3)] wherein the pressing means is a roller (e.g., 20);

[claim 29] further comprising a scribing apparatus including a scribing line forming means (e.g., 11) for forming a scribing line in the first surface of the brittle substrate, wherein the pressing means such that the pressing means moves along the scribing line while the first holding means and the pressing means oppose each other with the brittle substrate therebetween and while the scribing line forming means forms the scribing line on the first surface of the brittle substrate;

[claim 30] wherein a scribing apparatus comprises a scribing line forming means (e.g., 11) for forming the scribing line on the first surface of the brittle substrate while the first surface of the brittle substrate is held, the scribing apparatus further comprising the brittle substrate cutting system (e.g., as best understood); and

the scribing line forming means further comprises a pressing means for pressing the second surface opposing the first surface of the brittle substrate.

Claim Rejections - 35 USC § 103

7. Claims 32 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Le Gras, pn 3,259,286.

Le Gras discloses an apparatus with almost every structural limitation of the claimed invention but lacks a second occurrence of the corresponding structure of the apparatus. It is noted that Le Gras discloses the structure set forth in these claims in the same manner as described above for claim 1 and the corresponding dependent claims. However, the Examiner takes Official notice that it is old and well known in the art to treat multiple portions of a workpiece simultaneously or serially to efficiently machine a

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workpiece; for example, to conserve time and space. Therefore, it would have been obvious to one having ordinary skill in the art to provide additional cutting such breaking/cutting on or with the structure of Le Gras to make additional cuts simultaneously and/or serially to gain the well known benefits including those described above.

Response to Arguments

8. Applicant's arguments filed September 2, 2010 have been fully considered but they are not persuasive. It is respectfully submitted that, as best understood, the prior art continues to teach and/or suggest the claimed invention as described in further detail above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLARK F. DEXTER whose telephone number is (571)272-4505. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/CLARK F DEXTER/
Primary Examiner, Art Unit 3724**

cf
June 19, 2011